REMARKS

The foregoing amendment is responsive to the Office Action mailed on July 3, 2002 (hereinafter "the Office Action"). Applicants' representative would like to initially thank Examiners Haq and Coggins for the courtesy they extended during the telephone interview.

I.   Summary of the amendments

By the foregoing Amendment, the pending claims have been amended as shown in redline form on the attached pages. In addition, dependents Claim 10 and 11 have been canceled, and new Claims 56-62 have been added. No new matter has been added by this Amendment.

New Claim 57 is the claim that was proposed during the telephone interview, and is discussed separately below.

II.   Provisional Double Patenting Rejection

In the Office Action, the Examiner provisionally rejected Claims 1, 13, 18, 36, 45 and 53 under the doctrine of obviousness-type double patenting as being unpatentable over specific claims of co-pending Appl. No. 09/377,447. Pursuant to MPEP 804(I)(A), and in view of the pending status of Appl. No. 09/377,447, Applicants request that the provisional obviousness-type double patenting rejection be held in abeyance.

III.   Indefiniteness Rejection

In response to the indefiniteness rejection of Claims 18-24 and 45-55, the claims have been amended as follows:

- Claims 18, 45 and 53 have been amended to specify that the method is implemented by computer; and

- Claim 20 has been amended to depend from Claim 19, so that antecedent basis is provided for "the implicit membership community."

IV.   Anticipation Rejection

Independent Claim 18, and corresponding dependent Claims 21, 23, 33 and 34, stand rejected as being anticipated by Information Week, *Just Add People*. Applicants respectfully submit that this rejection is improper because, among other reasons, *Just Add People* does not disclose every limitation of independent Claim 18.

For example, *Just Add People* does not disclose "identifying a second user that ... has engaged in business with the merchant," as recited in Claim 18. In this regard, a user may rate a

web site, web page, or other resource, as disclosed in *Just Add People* (see paragraphs 1 and 5 on page 2), without engaging in business with a merchant.

In addition, *Just Add People* does not disclose "electronically notifying the first user of the contact information of the second user to allow the first user to communicate with the second user about the merchant." In this regard, there is no mention in *Just Add People* of the presentation of "contact information." Rather, it appears that the users can communicate in the disclosed system only by posting comments that may be viewed by many other users.

Dependent Claims 21, 23, 33 and 34 recite additional limitations that are not disclosed by *Just Add People*. For example, with respect to Claim 21, as amended herein, *Just Add People* does not disclose accessing "a merchant-to-user mapping table which maps merchants to users that have engaged in business with such merchants for each of a plurality of communities."

With respect to Claim 23, *Just Add People* does not disclose that "the merchant is a seller on an online auction Web site, and the first user is electronically notified of the second user in response to an action performed by the first user while browsing the Web site." In this regard, there is no disclosure or suggestion in *Just Add People* to use the features disclosed therein to assist users in evaluating sellers on an online auction Web site.

With respect to Claims 33 and 34, *Just Add People* does not disclose that "the community is an explicit membership community of which the first user is a member." In this regard, the "group" referred to in the cited portion of *Just Add People* is not an "explicit membership community," but rather is merely a set of users specified by a particular user who is seeking recommendations. (Note that the phrase "explicit membership community" is used throughout the present application to refer to a community that users explicitly join; see, e.g., page 3, lines 1-12.)

In view of the foregoing and other limitations that are not disclosed in *Just Add People*, Applicants respectfully submit that the anticipation rejections are improper.

V.   Obviousness Rejection

Because Applicants believe that the independent claims are patentably distinct from the cited art, they will limit their discussion of the obviousness rejection to the independent claims. By doing so, Applicants do not intend to imply an agreement with the positions taken by the Examiner with respect to specific dependent claims.

Independent Claims 1, 13, 36, 45, 53 stand rejected on obviousness grounds over a combination of the following U.S. Patents: Bieganski (6,321,221), Chislenko (6,041,311) and Jacobi (6,064,980) (collectively "the applied references"). Applicants will treat these references as prior art for purposes of responding to the Office Action, but reserve the right to later disqualify one or more of these references as prior art.

For the reasons set forth below, Applicants respectfully submit that the obviousness rejection is improper.

A. The applied references do not disclose or suggest every limitation of any independent claim

In order to establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. See MPEP § 2143.03. As set forth below, the applied references do not satisfy this requirement with respect to independent Claims 1, 13, 36, 45 and 53.

Independent Claim 1

By the foregoing amendment, Claim 1 has been amended to require that the recited community be an "explicit membership community." Claim 1 has also been amended to specify that the step of notifying the first user includes "supplementing an item detail page of the electronic catalog with a notification message to personalize the item detail page for the first user" (see Figures 3 and 8 of the present application, which depict one embodiment of this feature).

Applicants submit that these added limitations provide patentable distinctions over the applied references. With respect to the "explicit membership community" limitation, the "affinity groups" or "neighborhoods" disclosed in Bieganski are not "explicit membership communities," as they are not explicitly joined by users. (As indicated above, the phase "explicit membership community" is used throughout the present application to refer to a community or group that users explicitly join; see, e.g., page 3, lines 1-12.) Rather, these affinity groups or neighborhoods are generated by a recommendation engine by searching for users that have similar profiles. See Bieganski at col. 6, lines 38-47.

With respect to the "supplementing an item detail page ..." language, none of the applied references discloses or suggests a notification mechanism that involves supplementing an item detail page of an electronic catalog with a notification message to personalize the item detail page

for the user. Chislenko discloses notifying one user that another user shares a common interest in a recording artist, but does not suggest doing so by supplementing/personalizing an item detail page. A significant benefit of supplementing item detail pages, as claimed, is that the current user can very quickly and efficiently identify another user who has purchased the catalog item the first user is now viewing. The cited references do not disclose or suggest such a capability.

Applicants also respectfully disagree with the Examiner's assertion that the combination of Bieganski and Chislenko suggests "identifying a second user that both (a) has purchased the item and (b) is a member of a community associated with the first user," and "in response to identifying the second user, electronically notifying the first user that the item has been purchased by the second user," as recited in Claim 1. In this regard, neither reference even suggests exposing the purchases made by one user to another user.

As disclosed in the present application, the ability to learn of purchases made by other users, as set forth in Claim 1, allows users to better evaluate the items displayed within an electronic catalog. For example, a current user may navigate the electronic catalog to the detail page of a particular book (see Figure 3 of the present application), and immediately identify, and possibly initiate communications with, a friend or colleague who purchased that book. Knowledge that the friend or colleague purchased the book may significantly help the current user make an informed purchase decision, particularly if the friend or colleague has expertise in the field to which the book pertains. The ability to communicate with prior purchasers of the book may similarly be extremely useful to the current user in deciding whether to purchase the book.

Because the applied references do not disclose or suggest every limitation of Claim 1, the obviousness rejection of Claims 1-9, 12, and 25-27 is improper and should be withdrawn.

<u>Independent Claim 13</u>

In rejecting Claim 13, the Examiner took the position that the user profiles disclosed in Bieganski constitute "a data structure which maps items from the catalog to users that have purchased such items," as set forth in Claim 13. Office Action at page 7. While Applicants respectfully disagree with this position, they have nevertheless amended Claim 13 to more clearly distinguish the claimed data structure from the user profiles of Bieganski. Specifically, Claim 13 has been amended to replace "a data structure" with "an item-to-user mapping table." The generation and use of such a table provides a highly efficient mechanism for identifying, in real

time, those who have purchased the product, as may be desirable for dynamically generating supplemented item detail pages of the type shown in Figure 3. See present application at, e.g., Figures 6 and 8; page 16, lines 14-21; and page 22; lines 12-25.

Applicants also respectfully submit that the applied references do not suggest a "personalization process" which operates as recited in the second sub-paragraph of Claim 13. For example, none of the applied references suggests a personalization process which "responds to an online request by a first user to view a description of an item from the catalog" by at least identifying "a second user that both has purchased the item and is a member of a community associated with the first member." The user profiles disclosed in Bieganski are not used for such a purpose, but rather are used to identify users with similar preferences for purposes of providing personalized recommendations.

Because the applied references do not disclose or suggest every limitation of Claim 13, the obviousness rejection of Claims 13-17 is improper and should be withdrawn.

Independent Claim 36

The applied references also fail to suggest all of the limitations of Claim 36. For example, the applied references do not disclose or suggest "a personalization component which is responsive, to an online request from a first user for a catalog page that includes a description of a first item, by at least (a) determining whether the first item has been purchased by a second user who belongs to a selected group of said plurality of groups, said selected group being associated with the first user, and (b) in response to detecting that the first item has been purchased by the second user, notifying the first user during browsing of the electronic catalog that the first item has been purchased by the second user." In this regard, as mentioned above, the applied references do not even disclose notifying one user of purchases made by other users of the catalog. In view of this and other distinctions, Applicants submit that Claims 36-44 are patentably distinct from the applied references.

Independent Claim 45

The applied references also fail to suggest all of the limitations of Claim 45. For example, the applied references do not disclose or suggest "monitoring online browsing of the electronic catalog by a first user to detect that an item accessed by the first user has been purchased by a second user that is a member of a community associated with the first user, as

reflected by the purchase history data and the community data." In addition, as discussed above, the applied references do not disclose or suggest "in response to detecting that the item has been purchased by the second user, supplementing a catalog page requested by the first user to include a notification that the item has been purchased by the second user."

Because the applied references do not disclose or suggest every limitation of Claim 45, the obviousness rejection of Claims 45-52 is improper and should be withdrawn.

<center>Independent Claim 53</center>

The applied references also fail to suggest all of the limitations of Claim 53. For example, the applied references do not disclose or suggest "maintaining personal address book data for each of a plurality of the users." The Examiner appears to have disregarded this claim language in rejecting Claim 53.

In addition, the applied references do not disclose or suggest "monitoring online browsing of the electronic catalog by a first user to detect that an item accessed by the first user has been purchased by a second user that is included in a personal address book of the first user, as reflected by the purchase history data and the personal address book data." Further, the applied references do not disclose or suggest "in response to detecting that the item has been purchased by the second user, supplementing a catalog page requested by the first user to include a notification that the item has been purchased by the second user."

Because the applied references do not disclose or suggest every limitation of Claim 53, the obviousness rejection of Claims 53-55 is improper and should be withdrawn.

B.   The applied references do not suggest the desirability of the invention, and therefore have not been properly combined

As set forth in MPEP 2143.01, in order to establish obviousness based on a combination of references, the prior art must suggest the desirability of the claimed combination. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01 (emphasis original), citing In re Mills, 916 F.2d 680; 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicants respectfully submit that the applied references do not teach the desirability of the claimed invention. Specifically, none of the applied references suggest the benefit of

selectively notifying users of an electronic catalog of purchases made by their peers (e.g., fellow community members), as defined in the claims, as a mechanism for assisting users in evaluating and selecting items from the electronic catalog. All three of the applied references instead focus on the problem of generating reliable, personalized recommendations. Chislenko's disclosure that two users may be notified of their common interest in a recording artist, based on ratings submitted by such users, does not suggest the desirability of exposing user purchases as claimed.

Because the Examiner has not identified any suggestion, in the applied references or elsewhere, of the desirability of the claimed invention, the obviousness rejections of independent Claims 1, 13, 36, 45, 53 and their respective dependent claims is improper.

VI.   New Claims

As discussed during the telephone interview, new independent Claim 57 recites a number of patentable distinctions over the applied references. For example, Claim 57 recites "a user interface through which the users can selectively elect to expose their respective purchase histories to other users," and includes limitations regarding the use of permission data collected via this interface. (The limitations involving the user interface and the permission data are supported by the following and other portions of the original application: Figure 1, elements 36 and 40; page 9, lines 23 and 24; and Figure 5, which depicts a user database that stores users' "service preference data.") In view of these and other distinctions, Applicants submit that new Claims 57-62 are patentably distinct from the applied references.

VII.   Conclusion

For the foregoing reasons, Applicants request that the Examiner withdraw the outstanding rejections and allow the application.
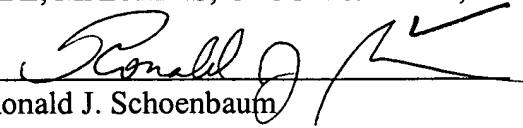
If any issues remain which can potentially be resolved by telephone, the Examiner is invited to call the undersigned attorney of record at his direct dial number of 949-721-2950.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: ___11-11-02___   By: _____
                                   Ronald J. Schoenbaum
                                   Reg. No. 38,297
                                   Customer No. 20,995

VERSION WITH MARKINGS TO SHOW CHANGES MADE

1. (Twice amended) A method of assisting users in evaluating items of an electronic catalog of items, the catalog accessible to users of an online store that provides services for allowing users to purchase items from the catalog, the method comprising the computer-implemented steps of:

identifying an item to be displayed to a first user;

identifying a second user that both (a) has purchased the item and (b) is a member of a community associated with the first user, said community representing a subset of a general user population and being an explicit membership community; and

in response to identifying the second user, electronically notifying the first user that the item has been purchased by the second user, and providing contact information of the second user to the first user to allow the first user to communicate with the second user about the item

wherein electronically notifying the first user comprises supplementing an item detail page of the electronic catalog with a notification message to personalize the item detail page for the first user.

13. (Twice amended) A system for assisting users of an online store in evaluating items of an electronic catalog of items, the system comprising:

[a data structure]an item-to-user mapping table which maps items from the catalog to users that have purchased such items; and

a personalization process which responds to an online request by a first user to view a description of an item from the catalog by at least (a) accessing the [data structure]item-to-user mapping table to identify a second user that both has purchased the item and is a member of a community associated with the first member, and (b) displaying contact information of the second user to the first user in conjunction with the description of the item such that the contact information is presented to the second user during browsing of the electronic catalog.

14. (Amended) The system of Claim 13, wherein the **[data structure]**item-to-user mapping table maps items to users that purchased the items for each of a plurality of communities, and the process uses the data structure to locate a fellow community member that purchased the item.

15. (Amended) The system of Claim 13, wherein the **[data structure]**item-to-user mapping table contains the contact information of users.

18. (Twice Amended) A computer-implemented method of assisting a first user in evaluating a merchant, comprising:

> identifying a community associated with the first user;

> identifying a second user that is a member of the community and that has engaged in business with the merchant; and

> electronically notifying the first user of the contact information of the second user to allow the first user to communicate with the second user about the merchant, wherein electronically notifying the first user comprises personalizing a web page requested by the first user during a browsing session.

20. (Amended) The method of Claim **[18]**19, wherein the implicit membership community is based on email addresses of users.

21. (Amended) The method of Claim 18, wherein electronically notifying comprises accessing a **[data structure]**merchant-to-user mapping table which maps merchants to users that have engaged in business with such merchants for each of a plurality of communities.

45. (Amended) A computer implemented method of assisting users in selecting items to purchase from an electronic catalog of items, the method comprising:

> maintaining purchase history data for each of a plurality of users of the electronic catalog;

       maintaining community data indicative of user memberships within specific user communities, wherein each of the user communities represents a respective subset of a general user population;

       monitoring online browsing of the electronic catalog by a first user to detect that an item accessed by the first user has been purchased by a second user that is a member of a community associated with the first user, as reflected by the purchase history data and the community data; and

       in response to detecting that the item has been purchased by the second user, supplementing a catalog page requested by the first user to include a notification that the item has been purchased by the second user.

53. (Amended) A <u>computer implemented</u> method of assisting users in selecting items to purchase from an electronic catalog of items, the method comprising:

       maintaining purchase history data for each of a plurality of users of the electronic catalog;

       maintaining personal address book data for each of a plurality of the users;

       monitoring online browsing of the electronic catalog by a first user to detect that an item accessed by the first user has been purchased by a second user that is included in a personal address book of the first user, as reflected by the purchase history data and the personal address book data; and

       in response to detecting that the item has been purchased by the second user, supplementing a catalog page requested by the first user to include a notification that the item has been purchased by the second user.